

Application No. 10/777,148
Response to Office Action mailed October 22, 2004

REMARKS

As a preliminary matter, the undersigned attorney for applicant notes that the office action mailed October 22, 2004 was not accompanied by a form PTO-1449 indicating that the Examiner had considered the references identified in the IDS filed on June 28, 2004. A copy of that form PTO-1449 is attached for the Examiner's reference. The Examiner is kindly asked to initial the form PTO-1449 to indicate that the references have been considered.

In the Office Action mailed October 22, 2004, claims 1 and 19-24 were rejected, while claims 2-18 and 25 were deemed allowable if amended to be written in independent form to include the limitations of their respective base claims and any intervening claims. Claims 1-25, as originally presented, are being submitted for the Examiner's consideration in view of the arguments below.

Rejection under 35 USC 102(b) of claims 1 and 19-24 as being anticipated by USP 6,299,389 to Barazani

The Examiner's entire rejection of these claims, which appears on the first full page of the "DETAILED ACTION", is as follows:

Barazani discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a cartridge pocket (34), an insert pocket (52), a detachable cutting insert (20), a through bore (53), a top abutment (5) and a primary forward abutment (28).

It is first submitted that the Examiner has failed to show how this reference discloses each and every element of independent claims 1 and 19; a list of 'some of the claimed elements' does not satisfy the Examiner's obligation. In particular, the Examiner has not indicated what he considers to be a "cartridge pocket retaining portion", which is an element appearing in pending claims 1 and 20. It is further submitted that the Examiner has failed to show that the elements listed are arranged in the manner recited by the claims. Accordingly, the Examiner's rejection is traversed.

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Pending Independent Claim 1 includes the following three limitations, none of which are disclosed by Barazani:

- (1) the clamping portion (of the cartridge) being resiliently transformable between a normally non-expanded state and a biased expanded state,
- (2) the clamping portion . . . is securely retained in the cartridge pocket retaining portion when in the biased expanded state, and
- (3) the insert pocket and the cutting insert are located external to the cartridge pocket retaining portion.

In Barazani's cartridge 18¹, the resilient clamping portion is defined by the base jaw 48 and the clamping jaw 50 having a lower side 54 and an upper side 56, respectively, which serve as first and second clamping abutment surfaces, respectively. As explained at col. 5, lines 34-46:

The first and second clamping abutment surfaces 54 and 56, respectively, taper towards the rear of the insert-retaining member 18 forming between them a taper angle. The taper angle is, preferably, approximately 2°. The distance, h_2 , between the first and second clamping abutment surfaces 54 and 56, respectively, taken approximately at the mid point of the second clamping abutment surface 56, is approximately equal to h_1 . Therefore, due to the tapering of the clamping abutment surfaces, when the insert-retaining member 18 is mounted in the gap 34 and urged towards the rear of the gap, it will, at first, slide in without resistance until it is approximately halfway into the gap. In order to complete the mounting of the insert-retaining member, so that it is fully retained in the gap, force has to be applied to the insert-retaining member. (emphasis added).

With regard to item (1), it is noteworthy that force must be applied to urge the resilient clamping portion of Barazani's cartridge 18 into the cartridge pocket 34². This means that the base jaw 48 and clamping jaw 50 are biased towards each other in a compressed state by the substantially parallel first and second clamping surfaces 28, 32 of the cartridge pocket 34. Thus,

¹ Barazani calls his cartridge an 'insert retaining member'

² Barazani calls his cartridge pocket a 'gap'

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contrary to item (1) above, Barazani's clamping portion does not have a 'normally non-expanded state' or a 'biased expanded state'; Barazani has the *opposite*: a normally expanded state, and a biased non-expanded (in fact, compressed) state.

With regard to item (2), Barazani again teaches the exact opposite. By virtue of the 'force', Barazani's cartridge is securely retained in the cartridge pocket only in the biased non-expanded state. This clearly is in contrast with the language of pending claim 1, which specifies that the cartridge is securely retained when in the "biased expanded state".

With regard to item (3), Barazani's Figs. 1 & 2 show Barazani's cartridge pocket retaining portion³ 16. The cartridge pocket retaining portion 16 comprises a base jaw 26 and the clamping jaw 30 on which are formed first and second clamping surfaces 28 and 32, respectively, of the cartridge pocket 34. As discussed above, and as best seen in Fig. 2, Barazani's cartridge 18 is wedged between the first and second clamping surfaces 28 and 32 of the cartridge pocket 34, and insert pocket 52 is located between the base jaw 48 and the clamping jaw 50 of the cartridge 18. It is therefore clear that in Barazani's assembled device, the insert pocket 52 is located *internal* to the cartridge pocket retaining portion 16. This is completely the opposite of the language of pending claim 1, which calls for the insert pocket to be "located external to the cartridge pocket retaining portion". (emphases added).

Pending Independent Claim 19 includes the following three limitations, none of which are disclosed by Barazani, for substantially the same reasons given above with respect to claim 1:

- (4) the clamping portion (of the cartridge) being resiliently transformable between a normally non-expanded state and a biased expanded state,
- (5) the clamping portion . . . being securely retained in the cartridge pocket retaining portion when in the biased expanded state, and
- (6) the insert pocket and the cutting insert located external to the cartridge pocket.

³ Barazani seems to call his cartridge pocket retaining portion a 'clamping portion'

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In view of all the foregoing, it is submitted that Barazani does not disclose at least three distinct features recited in either claim 1 or claim 19, and so Barazani cannot anticipate these claims, let alone be "identical to the claimed invention", as alleged by the Examiner. If the Examiner were to maintain the present rejection of claims 1 and 19, the Examiner is kindly asked to address each of these three points and explain how Barazani discloses the aforementioned limitations.

Pending Dependent Claim 20 recites a "slit traversing the clamping portion" and a "through bore located partially in the slit traverses the clamping portion." It is submitted that Barazani does not disclose such an arrangement. The Examiner is kindly asked to identify how Barazani meets this combination of features, in the event that the rejection is maintained.

Pending Dependent Claim 22 recites that "each end region of the through bore is slightly oval in shape". It is submitted that Barazani does not disclose this. The Examiner is kindly asked to identify how Barazani meets this claim element, in the event that the rejection is maintained.

With respect to all claims not specifically mentioned, it is submitted that these are patentable not only by virtue of their dependency on their respective base claims and any intervening claims, but also for the totality of the features recited therein.

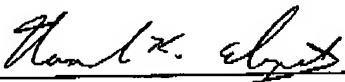
Reconsideration of the application is requested. Claims 1-25 are believed to be in allowable form and define over the prior art of record. An early notice of allowance is requested so that the application may proceed to issue.

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No fee is believed to be due for this submission. Should a fee be required, the Commissioner is authorized to charge any such fee to Womble Carlyle's Deposit Account No. 09-0528.

Respectfully Submitted,

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